

REMARKS/ARGUMENTS

Reconsideration and allowance of the present application based on the following remarks are respectfully requested.

Upon entry of the above amendments, claims 1-19, as amended, will be pending.

Applicants note with appreciation that claims 1, 3-8 and 15-19 are allowed, that claim 2 is merely objected to (as not further limiting claim 1) and that claims 9-14 are free of the prior art but include indefinite language. Accordingly, the foregoing amendments address the rejections as applied to claims 9, 10 and 11, while the rejections of claims 2 and 12 are respectfully submitted to be incorrect for the reasons discussed below.

Specifically, “actones” in claim 9 is corrected to --lactones-- (see, e.g., page 2, lines 30-32). Accordingly, the rejection of claim 9 as indefinite under 35 U.S.C. § 112, second paragraph, is traversed and should be withdrawn.

Claims 10 and 11 are amended to clarify that the ratio of “p” to “q” is a numerical ratio, rather than a molar ratio (see, e.g., page 6, lines 19-20). The paragraph on page 4, lines 20-25 is amended to reflect the correct nature of the ratio (and also to make a grammatical change in the last sentence). Accordingly, the rejection as applied to claims 10 and 11 is respectfully traversed and should be withdrawn.

With regard to the objection of claim 2 under 37 CFR 1.75(c) as not further limiting claim 1 from which claim 2 depends, reconsideration is requested for at least the following reason.

According to claim 1, the backbone chain contains “side chains of two or more different types of polyester chain.” In contrast, claim 2 is directed to the embodiment of the invention wherein the dispersant contains “side chains from two different types of polyester chains.” Therefore, claim 2 further limits the subject matter of claim 1 by reciting only two side chains whereas claim 1 permits “two or more” side chains.

Therefore, reconsideration and withdrawal of the objection to claim 2 is kindly requested.

With regard to the rejection of claim 12 as indefinite because “lauric acid” is not a hydroxycarboxylic acid, reconsideration is respectfully requested for at least the following reasons.

As set forth in claim 9, "Y is the residue of a polyester chain which is derivable from one or more hydroxycarboxylic acids ... or lactones thereof." As set forth in claim 12, "Y is the residue of a polyester chain derivable from lauric acid, ϵ -caprolactone and δ -valerolactone." Accordingly, the hydroxy carboxylic limitation is not a necessary selection for "Y" but may be a lactone thereof.

In this regard, the Examiner is referred to the disclosure on pages 2-6 which sets forth representative preparation routes. From page 5, lines 4-15 it is explained that in one embodiment part of the preparation of the polyester chain involves a polyester chain, optionally reacted with a polymerization terminating compound. Further, the polymerization terminating compound may be a carboxylic acid (*see*, page 5, lines 15-16) with one such carboxylic acid being lauric acid (*see, e.g.*, page 6, lines 24-25). Claim 12 is directed to the embodiment wherein lauric acid, ϵ -caprolactone and δ -valerolactone, namely, all three compounds are used to make the polyester chain and includes lactone compounds as well as a polymerization terminating compound.

Therefore, in view of the foregoing, claim 12 is not indefinite but is directed to an embodiment of the invention included within the scope of claim 9 from which claim 12 depends. Reconsideration and withdrawal of this ground of rejection is, therefore, respectfully requested.

It is understood that the rejections of claims 13 and 14, are based on their dependencies from claim 12 or claim 9, respectively, and otherwise are allowable.

Therefore, all objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

An Information Disclosure Statement is being filed concurrently herewith and on the accompanying Form PTO-1449, the documents discussed on page 1 of the specification are listed.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By: Richard A. Steinberg
Richard A. Steinberg
Registration No. 26,588
Direct No. (703) 905-2039

Paul L. Sharer
Registration No. 36,004
Direct No. (703) 905-2180

PLS/RAS
1600 Tysons Boulevard
McLean, VA 22101
(703) 905-2000 Telephone
(703) 905-2500 Facsimile

Date: January 28, 2004
Attachment: Information Disclosure Statement with fee